



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicants : Rogers et al
Serial No. : 10/757,229
Filed : January 14, 2004
Title : **PRINTING BLANKET SLEEVE SOUND DAMPENING FEATURE**
Docket : DAY0807VA/40195.817
Examiner : E. San Martin
Art Unit : 2837
Conf. No. : 3259

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Commissioner for Patents
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Attorney

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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection mailed August 23, 2005, in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal and a Request for a one-month extension of time in which to respond to the final rejection. Review is requested for the reasons stated below.

The present status of claims is: claims 1-9 are pending. Claims 1-9 stand rejected under 35 USC §103 as unpatentable over Mahl (US 3998347) in view of Caldwell (US 3160549). Applicants filed an Amendment After Final Rejection on October 21, 2005. In the Advisory Action mailed December 2, 2005, the Examiner refused to enter the Amendment After Final and maintained the rejection of claims 1-9.

Applicants submit that the rejection is not well taken in that: clear errors of fact have been made; clear deficiencies in the references omit one or more essential elements of the claimed invention needed to establish a prima facie case; and, clear deficiencies exist in the record with respect to motivation or suggestion to combine the reference teachings. Applicants will discuss each deficiency in the rejection in turn.

Errors of Fact

In the Final Rejection, page 2, the Examiner asserted that “Mahl teaches a sound dampening pad ... having a generally J-shaped configuration when viewed from an end thereof.” That statement contains two factual errors. Mahl teaches an elastomeric ring seal for a bell jar, not a sound dampening pad. Nowhere does Mahl teach or suggest that the sealing ring functions or is capable of functioning as a sound dampening pad. Further, Mahl’s ring is continuous and thus has no “end.” One cannot view Mahl’s ring “from an end thereof,” and Mahl’s continuous ring cannot have a J-shaped configuration *when viewed from an end thereof*.

In the Final Rejection, page 4, the Examiner asserted that “Mahl’s material shows curves, providing it with a generally curved J-shaped configuration.” Nowhere does Mahl teach, suggest, or depict his elastomeric sealing ring 22 as having any curved surfaces. Rather, as shown in all of the drawing figures, sealing ring 22 has flat and straight surfaces, not curved, surfaces.

These erroneous factual assertions by the Examiner were used to support his conclusion that claims 1-9 were obvious. Thus, the rejection, based on erroneous facts, cannot stand.

Clear deficiencies in the references omit one or more essential elements of the claimed invention needed to establish a prima facie case.

As clearly described and depicted, Mahl’s seal is a continuous elastomeric ring. See, col. 2, lines 39-40. Applicants’ sound dampening pad is a finite length of material. See, specification at page 6, paragraph [0025]. A continuous ring has no “end,” and thus Mahl’s ring cannot and does not have a “curved J-shaped configuration when viewed from an end thereof” as claimed. That Mahl states that his ring has a “J-shaped cross section” provides no basis that his ring has such a configuration “when viewed from an end thereof.”

Further, the claimed sound dampening pad has a “generally curved” J-shaped configuration [when viewed from an end]. The Examiner apparently conceded at one point in the Final Rejection, page 3, that Mahl did not explicitly show such a configuration. Rather the Examiner argued that he considered such a claimed feature to be “an obvious matter of design choice” [page 3] and that such a difference was only “slight” [page 4]. However, an Examiner’s conclusory characterization of a specific claim recitation as an obvious matter of design choice

does not make the claimed invention, taken as a whole, obvious in the absence of factual evidentiary support that one skilled in the art would be motivated to make the asserted modifications to the prior art. *See, Ex parte Petersen*, 228 USPQ 216, 217 (PTOBPAI 1985). And, structural distinctions from the prior art, whether “slight” or not, must be evaluated in terms of the whole invention, including whether the prior art provides a teaching or suggestion to make the asserted modifications. *See, Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323-24 (Fed. Cir. 1990).

Here, the Examiner has provided no factual evidence, teaching, or suggestion *in the prior art* to make the proposed modification to Mahl. And, as will be discussed in greater detail below, one skilled in the art would not modify Mahl in this manner. As neither Mahl nor Caldwell teach or suggest a sound dampening pad having a generally curved J-shaped configuration when viewed from an end thereof, the rejection fails because neither reference teaches at least one claimed feature of the invention.

Clear deficiencies exist in the record with respect to motivation or suggestion to combine the reference teachings.

The sole basis for combining the reference teachings provided by the Examiner in the Final Rejection was the assertion that it would have been obvious “to employ the Caldwell et al. pressure sensitive adhesive with the Mahl sound dampening pad because it would provide the sound dampening pad with a ready-to-lay convenience.” Final Rejection, pages 2-3. Mahl does not relate to a sound dampening device. Rather, Mahl is directed to a creep resistant elastomeric ring seal for a vacuum jar. Mahl describes several “fastening means” for preventing creep of the sealing ring, none of which utilize a pressure sensitive adhesive. Caldwell does not teach or suggest the use of a pressure sensitive adhesive for the purpose of preventing creep. Only through the use of impermissible hindsight has the Examiner combined these disparate reference teachings. Mahl is classified in class 215, Bottles and Jars, while Caldwell was located in class 181, Acoustics. The references are from different arts, and their teachings are not properly combinable.

Further, the Examiner has conceded that in order to arrive at the claimed invention, Mahl’s straight, flat surfaces in ring 22 must be modified to be curved. However, modifying

Mahl's seal to a curved configuration would render Mahl inoperable for his intended purpose. If a proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make such a modification. *See, In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). As shown in Fig. 2 of Mahl, the ring seal is directed to sealing a cylindrical bell jar by fitting the cross member against the planar rim of the jar. If the cross member 32 was modified to have a curved configuration, the curved cross member would not form an effective fit around the planar rim of the bell jar. Without a proper fit around the planar rim, the Mahl ring cannot perform its intended function, i.e., sealing a vacuum jar. As a result, modifying Mahl, as the Examiner proposed, would render Mahl inoperable for its intended purpose. Accordingly, there is no teaching or suggestion to make the proposed modification.

Conclusion

For all of the above reasons, applicants submit that the rejection is not well taken, is based on factual and/or legal errors and omissions, and should be withdrawn.

Respectfully submitted,

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